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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. RANK and JOHN C. PAMPUCH

Appeal 2008-004801
Application 09/774,354[1]
Technology Center 2100

Decided: December 10, 2009

Before JAMES D. THOMAS, JOHN C. MARTIN, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

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[1] Application filed January 30, 2001. The real party in interest is Sun Microsystems.

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-18, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellants invented a method and a computer usable medium for providing a spreadsheet program with formula support on small devices (like PDAs) while minimizing the amount of memory space used by not only the program, but also by the accompanying compiled code during transfer of files from the desktop to the small devices. (Spec. 27, Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-18. Claims 1 and 10 are independent claims. Claim 1 is illustrative:

> 1. A method in a data processing system for evaluating a spreadsheet file comprising:
>
> obtaining said spreadsheet file in a first format on a first device;
>
> converting said spreadsheet file to a second format wherein said converting further comprises evaluating one or more formulas associated with said spreadsheet file while converting said spreadsheet file to said second format; and
>
> transferring said spreadsheet file to a second device.

C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Schlafly	US 5,471,612	Nov. 28, 1995
Horie	US 6,487,597 B1	Nov. 26, 2002
Pajakowski	US 6,718,425 B1	Apr. 6, 2004

D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

(1) Claims 1-4 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horie in view of Schlafly; and

(2) Claims 5-9 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horie in view of Schlafly and further in view of Pajakowski.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Schlafly

1. Schlafly discloses that "the spreadsheet engine 135 includes a Formula Evaluator 136 of the present invention. The Formula Evaluator 136 processes the various formulas stored in a spreadsheet during spreadsheet recalculation." (Col. 7, ll. 34-37.)

2. In Schlafly, "formulas are compiled to machine code upon the first recalculation operation, typically when a spreadsheet is first loaded." (Col. 16, ll. 31-33.)

3. Schlafly discloses that "[t]he machine code is instead generated on-the-fly, at the first recalculation opportunity, with all subsequent

recalculation operations employing the in-memory compiled formulas to greatly increase recalculation speed." (Col. 16, ll. 52-56.)

III. PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker,* 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *In re Kahn,* 441 F.3d. 977, 985-986 (Fed. Cir. 2006).

IV. ANALYSIS

Grouping of Claims

In the Brief:

Appellants argue claims 1-18 as a group (App. Br. 4-8). For claims 2-18, Appellants repeat the same argument made for claim 1. We will, therefore, treat claims 2-18 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991).

The Obviousness Rejection

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

Horie and Schlafly Do Not Teach Evaluating While Converting

Appellants contend that "*Schlafly* indicates that formula evaluation is performed after compilation or conversion. . . . Accordingly, *Schlafly* does

not teach or suggest converting while evaluating." (App. Br. 5.) Appellants further contend that "nowhere does *Horie* suggest evaluating a formula during a conversion. This subject matter is simply not addressed in *Horie*." (Reply Br. 6.)

The Examiner found that "Schlafly teaches evaluating one or more formulas *(e.g., The Formula Evaluator 136 processes the various formulas stored in a spreadsheet during spreadsheet recalculation; col. 7; lines 34-40)*." (Ans. 5.)

Issue: Have Appellants shown that the Examiner erred in finding that Schlafly discloses *"evaluating one or more formulas associated with said spreadsheet file while converting said spreadsheet file to said second format"*?

Here, the Examiner concedes that Horie does not specifically teach "*evaluating one or more formulas associated with the spreadsheet file while converting*" (Ans. 5), but instead relies upon Schlafly to disclose this limitation. As such, we shall limit our discussion to the Examiner's interpretation of Schlafly.

The Examiner found that Schlafly uses a Formula Evaluator to process formulas/spreadsheets similar to the claimed invention. We agree. Specifically, Schlafly discloses that various formulas stored in a spreadsheet are evaluated during spreadsheet recalculation (FF 1). Schlafly further discloses that formulas are compiled (i.e., converted) to machine code upon the first recalculation operation (FF 2-3). Furthermore, Schlafly's Fig. 7 shows a runtime formula evaluation scheme with in-memory cell records for

formula results flowing to compiled formula segments. In other words, Schlafly discloses both evaluating formulas associated with a spreadsheet file and converting formulas to machine code *during* the same process, i.e., the first recalculation. As such, Schlafly reasonably discloses evaluating formulas *while* converting the formulas in the spreadsheet file. Thus, the claimed *"evaluating one or more formulas associated with said spreadsheet file while converting said spreadsheet file to said second format"* reads on Schlafly's above-noted Formula Evaluator functions.

There Is No Motivation To Combine

Appellants contend that "there is no motivation to combine the references found within the references themselves." (App. Br. 7.) Appellants further contend that "*Schlafly* teaches away from the limitations of claim 1. It is improper to combine references where the references teach away from their combination." (App. Br. 8.)

The Examiner found that "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Horie with Schlafly because Schlafly's teaching would have provided the enhanced capability for promoting the sharing of information between the personal computer 10 and the personal digital assistant 13." (Ans. 6.)

Issue: Have Appellants shown that there is no motivation to combine Horie and Schlafly and that Schlafly teaches away from evaluating formulas *while* converting the formula?

As noted *supra*, Schlafly discloses both evaluating and converting formulas *during a first recalculation process* (FF 1-3). While we agree with Appellants that Schlafly discloses an embodiment of performing a conversion *before* evaluating formulas (i.e., in subsequent recalculation operations)(*see* Schlafly, col. 16, ll. 52-56), the fact remains that Schlafly *also* discloses performing conversion *while* evaluating formulas during a first recalculation process. In other words, there is at least one instance in Schlafly (e.g., during the first recalculation) where both functions are being performed. Thus, Appellants' argument that Schlafly teaches away from the argued feature is unpersuasive.

Appellants further contend that "there is no motivation to combine the references found within the references themselves." (App. Br. 7.) We note that an "analysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969) ("Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any

specific hint or suggestion in a particular reference."'); *In re Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969) ("[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom …").

Here, the Examiner has found actual teachings in the prior art and has provided a rationale for the combination. Further, the teachings suggest that the combination involves the predictable use of prior art elements according to their established functions. Accordingly, we find that the Examiner has provided sufficient motivation for modifying Horie with the teachings of Schlafly.

Thus, Appellants have *not* persuaded us of error in the Examiner's conclusion of obviousness for representative claim 1. Therefore, we affirm the Examiner's § 103 rejection of independent claim 1 and of claims 2-18, which fall therewith.

V. CONCLUSION

We conclude that Appellants have *not* shown that the Examiner erred in rejecting claims 1-18.

Thus, claims 1-18 are not patentable.

VI. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-18.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

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